



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/714,987	09/17/1996	HUGH SHARKEY	17616-705	4099

23715 7590 03/28/2003

JOEL R. PETROW  
SMITH & NEPHEW, INC.  
1450 BROOKS ROAD  
MEMPHIS, TN 38116

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

3739

53

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/714,987

Applicant(s)

Shanbey et al

Examiner

L. Day

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on September 17 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 48, 50, 53-55, 74-94 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 48, 50, 53-55, 74-94 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 3739

The rejections under 35 USC 112, 1<sup>st</sup> paragraph set forth in the previous office action are hereby withdrawn in view of applicant's remarks.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 48, 50, 53, 74, 75, 77-83, and 85-88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cosman et al (1984).

Wherein the interior of the electrode is the conductive material and the surface of the electrode is the surface material. Any interstitial fluid present will provide the composite temperature readings referred to. See Figures 2 and 3 and page 946, column 2 to page 948, column 2.

Claims 74, 76, 82, and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al (1984) in combination with Cosman ('597). Cosman et al (1984) provide the teachings set forth above. Cosman ('597) teach forming electrodes of stainless steel. It would have been obvious to the artisan of ordinary skill to form the electrode of Cosman et al (1984) of stainless steel since this is a well known electrode material, and useful for forming thermocouple junctions, thus producing a device such as claimed.

Claims 54, 55, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosman et al (1984) in combination with Makower et al. Cosman et al (1984) provide the teachings set forth above. Makower et al teach the equivalence of microwave, radio frequency, and resistive heating in energy delivery devices. It would have been obvious to the artisan of ordinary skill to employ a resistive or microwave tissue heater in the device of Cosman et al

Art Unit: 3739

(1984), since these are well known equivalents in the art, as taught by Makower et al and provide no unexpected result, thus producing a device such as claimed.

Claims 48, 50, 53-55, 74-89, 93 and 94 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Makower et al.

Claims 89-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower et al. Makower et al disclose removing the applicator at page 20. It would have been obvious to the artisan of ordinary skill to re-insert the applicator e.g. if subsequent diagnosis determined that further treatment is needed, thus producing a method such as claimed.

Applicant appears to be arguing the claims as though they recite the thermal sensor as being enclosed, rather than embedded within the conductive material. To the extent that applicants are arguing that the sensor is merely embedded, the rejections of the apparatus claims set forth in the previous office action still apply (see e.g. temperature sensors 46 in figures 17 and 18 of Makower et al which having a surface flush with the surface of sheath 98 are embedded in the material therein, with the surfaces of elements 46 perpendicular to and opposite of the exposed surface being surrounded by conductive material). To the extent that applicants are arguing that the sensor is completely enclosed by the conductive material, these arguments are narrower than the claim language and are not convincing for this reason alone. However, such claims would also be anticipated/obvious in view of the rejections based on Cosman et al (1984).

In either case, the particular physical configuration does not manipulatively affect the claimed methods, thus the rejections based on Makower et al still apply.

Art Unit: 3739

Applicant's arguments filed January 27, 2003 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

Applicant's arguments with respect to claims 48, 50, 53-55, 74-88, and 94 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 703-308-2215.



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330

Shay/DI

March 20, 2003